BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

Opinions Of The Courts Below.

The opinion of the District Court for the Eastern District of New York herein appears in 45 F. Supp. 465, and the opinion of the Circuit Court of Appeals for the Second Circuit in 133 F. (2d) 763.

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decision of the Circuit Court of Appeals for the Second Circuit, which petitioner seeks to have reviewed, was entered March 3, 1943 (R. 378), and a petition for rehearing duly filed in that Court was denied by that Court on March 19, 1943 (R. 393).

Statement Of The Case.

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification Of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding the patent in suit invalid for lack of invention as to the claims in issue.

2. In holding the patent in suit invalid because the thing patented resulted from skillful experiments involving no imagination and insufficient talent and achieving a result not sufficiently unexpectable.

3. In holding that urea as a protective ingredient was a result achieved by other chemists contemporaneously through investigation indicated by familiar chemical principles.

4. In not holding the patent in suit valid and infringed as to the claims thereof in issue.

Argument.

The Circuit Court of Appeals for the Second Circuit decided herein that the thing patented lacks invention because its discovery did not involve "imagination", because the result was not "sufficiently unexpectable", and because "No particular talent" was involved in the process of development (Opinion, R. 381). The judicial inquiry was thus subjective, seeking to weigh the mental processes exercised by the patentees before they made their discovery.

In direct conflict with the doctrine so announced, the Circuit Court of Appeals for the Seventh Circuit in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812, stated that the objective test should apply in determining the question of invention,—that it is the character or personality of the thing invented as contrasted with what went before it rather than the mental process or method of discovery with which judicial inquiry is concerned. That Court said (pp. 816, 817, 818):

> "We are advised and believe that in the field of science nearly all advance is made in laboratories where many experiments are made and discoveries result from the trial and error method.
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> * * * * *
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> The test of '*flash* of genius' has been applied to curtain the field of patentable discovery and to eliminate from the protection of patents, all products (even though they came from the superior mind of genius)

which were, nevertheless, the product of prolonged study and step by step advance. In short, it would eliminate nearly all the advances of history, in science, and in the field of mechanics. All that would be left are the products and processes which come to a genius, only occasionally, as flashes. Only a matured child prodigy (if there is any such being) is capable of experiencing such flashes.

* * * * *

The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. The Federal decisions covering a century contain many to the effect that *it is the fact of accomplishment*,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned.*

The questions for the court are: What is the new product? What advance does it show over those in use or known to the art? Our interest is in the child, not in how or where it was born or who were its parents. Section 31, Title 35, U. S. C. A.

Nowhere in the statute can be found any words which require, or permit us to inquire into the quality of mind or the activity of the mind of the inventor to determine the patentability of his products or processes. Congress was interested in protecting the product of the mind,—not in whether it came as a flash to the mind or as a happy thought, or by long painstaking search and experimentation."

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*Citing *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 1911, 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527; *The Barbed Wire Patent* (*Washburn & Moen Mfg. Co.* v. *Beat 'Em All Barbed-Wire Co.*), 1892, 143 U. S. 275, 12 S. Ct. 443, 36 L. Ed. 154; *Webster Loom* v. *Higgins*, 1881, 105 U. S. 580, 26 L. Ed. 1177; *Krementz* v. *Cottle Co.*, 1893, 148 U. S. 556, 13 S. Ct. 719, 37 L. Ed. 558; *Eibel Process Co.* v. *Minnesota, etc.*, 1923, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523; *Minerals Separation Co.* v. *Hyde*, 1916, 242 U. S. 261, 37 S. Ct. 82, 61 L. Ed. 286.

An authoritative settlement of this conflict is of great importance to the public. Under the Second Circuit rule, patent protection is denied to scientists when, due to their faith, perseverance and confidence, they expect the result that they ultimately achieve through trial and error. Confidence in eventual achievement of a desired objective and persistent striving to attain it despite the discouragement of repeated failures has characterized the development of the most important scientific advances. Edison, confident of the result he sought, tried many unsatisfactory expedients before he produced a successful incandescent lamp*. The denial of patent protection to the scientist who strives by trial and error to attain his objective, and the tentative promise of protection to those who may by accident stumble on something of value that they did not seek or expect, will necessarily discourage and curtail intelligent research. Until the conflict here presented is resolved, the public will be deprived of such intelligently achieved developments as are promoted by patent protection.

Three intelligent analyses of the question of patentable invention indicate the importance of resolving the legal conflict herein presented.

In 1890, Robinson, in his work on patents, stated that the nature of the mental process productive of the new thing is of no consequence in determining invention.

> "The patient labors of a lifetime, the unpremeditated flash of an original thought upon the mind, the revelation made to an appreciative intellect by some trivial accident, all stand upon an equal footing both in character and merit, and are entitled to the same reward" (Robinson on Patents, Vol. 1, Sec. 83, p. 127).

About thirty-five years later Roberts, being convinced that reliable definitions of patentable invention must be

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*Edison Electric Light Co. v. United States Electric Lighting Co., 52 Fed. 300, 303-306 (C. C. A. 2, 1892).

found in the decisions of this Honorable Court, made a careful and exhaustive analysis of those decisions and found that with only three exceptions the criterion of invention applied was "wholly dependent upon objective evidence free from the influence of subjective bias", and that the test was applied to the physical thing devised "without regard to extraneous circumstances attending its origin or exploitation" (Patentability of Inventions and the Interpretation of Patents, by Roberts, Vol. 1, Chap. III, p. 245, see also pp. 170, 171 and 186).

About a year after his appointment to the Circuit Court of Appeals for the Second Circuit, Judge Jerome N. Frank was confronted with the question of invention in *Picard* v. *United Aircraft Corporation*, 128 F. (2d) 632. He quite properly felt "reluctantly constrained to join" the majority of that Court and accepted the test of invention that it applied* in view of the greater experience of his colleagues (128 F. (2d) at 639). In his concurring opinion, Judge Frank analyzed "the startling implications of Judge Hand's negative test of invention" (128 F. (2d) at 639). He noted that disinterested scientific advisers to the court would have to determine whether the thing patented is more than what results "through trial and error" and the "exercise of persistent and intelligent search for improvement", and that if the test were "informedly applied", "only an infinitesimal percentage of so-called inventions will be patentable" (128 F. (2d) at 640). He concluded as follows with regard to the application of the test under the existing system of judicial determination (p. 641):

> "If all that be true, then, perhaps, with exceedingly few exceptions, it will only be to the untrained eye of

*In the majority opinion, the Court, speaking through Judge Learned Hand, said:

> "Unless we are to mistake for invention the slow but inevitable progress of an industry through trial and error, and confer a monopoly merely upon the exercise of persistent and intelligent search for improvement, there was no invention in this" (128 F. (2d) at 636).

a member of the judiciary (i. e., to a scientific amateur) that anything will appear to be an invention. If Judge Hand's yardstick is applied, a valid patent will, usually, be a function of judicial scientific ignorance."

Conclusion.

It is urged, therefore, that the petition for writ of certiorari be granted.

Respectfully submitted,

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

Dated: New York, N. Y.,
June 16, 1943.

BRIEF FOR THE RESPONDENTS IN OPPOSITION

(4)

JUL 12 1943
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

October Term, 1943.

No. 108.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

AGAINST

F. W. WOOLWORTH COMPANY,

Respondent.

BRIEF ON BEHALF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

ROBERTS B. LARSON,
Counsel for Respondent.

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Supreme Court of the United States

OCTOBER TERM, 1943.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,
Petitioner,

AGAINST

F. W. WOOLWORTH COMPANY,
Respondent.

No. 108.

Brief on Behalf of Respondent in Opposition to Petition for Writ of Certiorari.

The petition for writ of certiorari raises no question of constitutionality, jurisdiction, conflict of decisions, local law or question of Federal law not heretofore settled by decisions of this Court or question of departure from accepted and usual course of judicial proceedings.

Apparently the petitioner desires to have this Court review its decision in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, in which the Court stated that the new device must reveal a "flash of creative genius", not merely the skill of the calling. The petitioner in his brief argues that the Second Circuit decision in this case and the Seventh Circuit decision in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2) 812, are in conflict. Actually, both courts held the patents which were before them to be invalid on the ground that the alleged inventions were "not beyond the ken or practice of the ordinary mechanic" (132 F. [2] 818) and "no particular talent was involved in developing the plaintiff's product" (R., p. 381).

The Seventh Circuit Court of Appeals analyzed and commented on this Court's "flash of creative genius" rule, whereas the Second Circuit Court of Appeals did not make reference to that rule. There, however, was no conflict on a point of law or the applicability of this Court's decision. Both Courts held in their respective cases that in view of the art there was no invention in the respective patents before them.

The Facts.

The patentees, Wallace and Hand, claim to have invented a perspiration inhibitor composition consisting of aluminum chloride and aluminum sulphate to which had been added urea for the purpose of neutralizing excess acidity.

The District Court for the Eastern District of New York (Judge Byers) held that the patent in suit "does not embody patentable invention over the prior art" (R., p. 371) and in its conclusion the Circuit Court of Appeals agreed (R., p. 381). Judge Byers was of the opinion that the Koch patent exemplified the prior art over which there was no invention (R., p. 371), whereas the Circuit Court of Appeals relied, not only upon the Koch patent, but upon other patents and prior knowledge. In this connection, the Circuit Court of Appeals held:

> "The plaintiff, Wallace, testified that in 1935 he knew that if urea was added to an acid it would reduce the acidity. The plaintiff's witness Killian testified that he possessed the same knowledge when he began his experiments early in 1936. U. S. Patent No. 2,011,292 to Koch (issued August 13, 1935) taught that a solution of aluminum formate containing 8 per cent. of urea could be used with special advantage in the textile industry because the compound did not contain any substances having 'a detrimental effect.' The U. S. Patent No.

2,174,534 to Shipp (issued October 3, 1939, the application for which was filed April 22, 1936) also suggested the use of urea to retard the deleterious effect of sulphuric acid upon cellulose fabrics. The U. S. Patent No. 2,145,583 to Carlson (issued January 31, 1939, the application for which was filed December 6, 1934) was for a shaving cream tending to stop perspiration under the arms. It mentioned aluminum sulphate as an anti-perspirant and included zinc stearate as a protective ingredient and stated that the mixture would be 'harmless to clothing.' Montenier in U. S. Patent No. 2,230,082 disclosed that the excess acidity of aluminum chloride was destructive to clothing fabrics in anti-perspirant compounds and prescribed the use of urethene, urea and other agents to counteract the effect of the excess hydrochloric acid.

In the Spring of 1935, the patentees in this case began to work on an anti-perspirant that would not injure clothing. First they used creosol sulphuric acid and found it too strong and accordingly added percentages of sodium hydroxide, citric acid, phosphoric acid and tartaric acid, but the result was unsatisfactory. They then tried 'a complete range of alkalis' to neutralize the acid and finally urea and related compounds. The urea seemed to do the trick and, when aluminum sulphate was used as an equivalent of the creosol sulphuric acid, produced a commercially satisfactory article that met with wide success."

On the basis of this prior art evidence, the Court of Appeals held the patent invalid.

Argument.

The lower tribunals were both of the opinion that the patent in suit did not disclose invention in view of the

prior art and prior knowledge and, they having so disposed of the case against the petitioner, this Court will not review such concurrent decisions. *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 178-179. Nor will this court review by certiorari evidence or specific facts. *Southern Power Co.* v. *North Carolina Public Service Co.*, 263 U. S. 508, 509.

Petitioner attempts, by argument, to create an alleged conflict of decision between the Second and Seventh Circuits, but it seems clear that there is no diversity of opinion. Both Courts held the patents which were before them to be invalid for want of invention over the prior art and prior knowledge, but both Courts nevertheless followed the well known rule that if the patent covered what was obvious the patent could not be sustained.

It is true that Judge Evans in his opinion in the Seventh Circuit case, was not disposed to apply the "flash of creative genius" test, but came to the conclusion that the patent before him lacked invention because the development of the subject matter thereof was within the capacity of the mechanic in the art. In the Second Circuit case the Courts came to the same conclusion without reference to the "flash of creative genius" rule. Therefore, there is no conflict of decision but rather harmony in the reasoning of the two Courts in arriving at the same conclusion of lack of invention in either patent.

CONCLUSION.

It is respectfully submitted that there is no merit in the petition for writ of certiorari and that the petition accordingly should be denied.

Respectfully submitted,

ROBERTS B. LARSON,
Counsel for Respondent.